

### **REMARKS**

Claims 1-17 are all the claims pending in the application. Please note that this Amendment has been formatted according to the Revised Format Now Permitted and, therefore, waiver of 37 C.F.R. § 1.121 is requested.<sup>1</sup> Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

#### **Specification**

The Examiner objected to the disclosure as including informalities. The Examiner noted specific instances of informality in item 3 on page 2 of the Office Action. Applicant has amended the specification as suggested by the Examiner and, thereby, has overcome this objection.

The Examiner also requested Applicant's cooperation in correcting any errors in the specification of which Applicant may become aware. Accordingly, Applicant has amended the specification to correct typographical and grammatical errors of which he is currently aware.

Further, the Examiner objected to claims 1, 8, and 10, as including informalities. Specifically, with respect to claim 1, the Examiner asserted that "aluminm film" should be --aluminum film--. However, Applicant could not find any instance of "aluminm" in claim 1. This objection is believed to apply to claim 2, wherein "aluminm" is set forth and, accordingly, Applicant has corrected this typographical error in claim 2. With respect to claims 8 and 10, Applicant has adopted the Examiner's suggestion to correct typographical errors.

#### **Drawings**

The Examiner objected to the drawings as failing to comply with 37 CFR § 1.84(p)(5) because they include the reference numeral "17" that is not mentioned in the specification. Applicant has amended the specification, at page 14, so as to include the reference numeral "17". Accordingly, this objection is believed to have been overcome.

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<sup>1</sup> See Pre-OG Notices as posted on the PTO website at  
[www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm).

Also, the Examiner objected to the drawings as failing to comply with 37 CFR § 1.84(p)(4) because the reference characters “16” and “19” point to the same part in Figs. 5 and 8. Accordingly, Applicant has submitted herewith a Request for Approval of Proposed Drawing Correction, wherein reference numeral “19” has been made to refer to the film comprised of the core material 16 and the layers 17 of deposition/coating film, in each of Figs. 5 and 8.

#### **Claim Rejections - 35 USC § 112**

The Examiner rejected claims 1-8, 10-12, 15, and 17, under § 112, 2<sup>nd</sup> paragraph, as indefinite. The Examiner asserted specific instances of indefiniteness in item 7 bridging pages 3 and 4 of the Office Action. Applicant has amended claims 1, 11, 12, and 15, in a manner believed to overcome this rejection. However, such an amendments do not narrow the claims, they merely redefine or rearrange what was already included and, therefore, do not subject the claims to prosecution history estoppel. See: *Turbocare Corp. v. General Electric Co.*, 60 USPQ.2d 1017 (Fed. Cir. August 29, 2001) (*Festo*<sup>2</sup> is not applicable to a claim wherein a limitation is only redefined without narrowing the claim.). Further, the Applicant's redrafting of the claims in response to the § 112 rejection was done strictly for cosmetic purposes and not for narrowing the scope of the existing claims. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 2002 U.S. LEXIS 3818, \*27 (May 28, 2002) (“If a 35 U.S.C. § 112 amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel.”).

#### **Claim Rejections - 35 USC § 102**

The Examiner rejected claims 1, 8, 11, 15, and 17, under § 102(e) as being anticipated by US Patent 6,038,205 to Katakura et al. (hereinafter Katakura). Applicant respectfully traverses this rejection because Katakura fails to disclose every element as set forth and arranged in Applicant's claims.

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<sup>2</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 USPQ.2d 1865 (Fed. Cir. 2000) (*en banc*), vacated and remanded, 2002 U.S. LEXIS 3818, (May 28, 2002).

Claim 1 sets forth a sealing member adapted to a rolling bearing, wherein the rolling bearing comprises an inner ring, an outer ring, and a plurality of rolling elements, the sealing member comprising a first portion substantially covering at least a part of the end part opening of the space between the inner and outer rings, and a second portion being bonded and fixed to an axial direction endmost surface of one of the inner and outer rings.

For example, as shown in Figs. 9A and B, one embodiment of the invention is a sealing member 102, 103 adapted to a rolling bearing 101, wherein the rolling bearing 101 comprises an inner ring 104, 105, an outer ring 106, 107, and a plurality of rolling elements 132, the sealing member 102, 103 comprising a first portion substantially covering at least a part of the end part opening of the space between the inner and outer rings, and a second portion being bonded and fixed (as at A) to an axial direction endmost surface of one of the inner and outer rings. Because the sealing member 102, 103 is adhered to the endmost surface of one of the inner and outer rings, the sealing member easily can be assembled, even when the axial direction size of the rolling bearing is made sufficiently small.<sup>3</sup>

In contrast to that set forth in claim 1, Katakura discloses a seal member 11 that is disposed at a position within the bearing so as to be located below the endmost face of either the inner or outer ring. See Katakura's Fig. 2, wherein annular member 9 is disposed on the endmost face of the outer ring (rightmost in Fig. 2), and further wherein seal member 11 is disposed beneath the annular member 9.

The Examiner attempts to equate the sheet sealing member of the present invention with Katakura's seal member 11. However, the sealing member in claims 1 and 11, as well as the sheet in claim 15, according to the present invention are disposed on an endmost surface of the bearing in an axial direction thereof. On the other hand, Katakura's seal member 11 is disposed on a vicinity of the end surface of the bearing (outer ring) in an axial direction. Namely, Katakura's seal member 11 is a conventional seal wherein, as usual, a periphery end portion thereof is inserted into a seal groove formed on an inner surface of one of the bearing rings (inner

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<sup>3</sup> Specification at page 4, 1<sup>st</sup> full paragraph.

or outer). Due to this construction of Katakura's seal member, thickness of the seal groove in an axial direction of the bearing is needed for carrying the seal member. Such a structure does not accommodate a demand for a thin motor.

Claim 11 sets forth a rolling bearing comprising a sealing member including a second portion that, similarly to the second portion of the sealing member in claim 1, is bonded and fixed to an axial direction endmost surface of one of inner and outer rings. Again, as noted above, Katakura fails to disclose a seal member fixed to an axial direction endmost surface of one of inner and outer rings of a bearing.

Claim 15 sets forth a bearing device wherein a sheet covering a gap between inner and outer rings is disposed externally on an endmost side of one end part in the axial direction of the bearing device. The sheet in claim 15 is similar to the second portion of the sealing member as set forth in claim 1. And as noted above, Katakura fails to disclose such a structure.

For at least any of the above reasons, Katakura fails to anticipate any one of claims 1, 11, and 15. Likewise, this reference also fails to anticipate dependent claims 8 and 17.

### **Claim Rejections - 35 USC § 103**

The Examiner rejected claims 2-4, 10, and 12, under §103(a) as being unpatentable over Katakura in view of US Patent 5,270,887 to Edwards et al. (hereinafter Edwards). Applicants respectfully traverse this rejection because the references fail to teach or suggest every element as set forth and arranged in Applicant's claims.

The Examiner asserts that Katakura teaches the sealing member as claimed, except for being made of a core layer, an aluminum film disposed on the core layer, and an adhesive layer disposed on the aluminum film.<sup>4</sup> However, as noted above, Katakura fails to teach or suggest that the sealing member 11 is disposed on an endmost surface of one of the inner and outer rings of a bearing.

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<sup>4</sup> October 9 Office Action at page 6, item 11, 2<sup>nd</sup> paragraph.

The Examiner then cites Edwards as teaching the use of a sealing tape comprising a core layer, an aluminum film disposed on the core, and an adhesive disposed on the aluminum film. However, Edwards does not teach or suggest a sealing member disposed on an endmost surface of one of inner and outer rings of a bearing. Instead, Edwards teaches a tape member 14 attached to a base 10 and cover 12 of a housing. That is, Edwards does not at all teach the use of a sealing member on a bearing and, therefore, it is doubtful that one of ordinary skill in the art would even combine this reference with Katakura.

Nonetheless, for the sake of argument, even assuming that one of ordinary skill in the art were motivated to combine Katakura with Edwards as suggested by the Examiner, any such combination would still not teach or suggest a sealing member disposed on an endmost surface of one of the inner and outer rings of a bearing, as set forth in Applicant's claims.

In light of the above, this rejection is believed to be in error, and should be withdrawn.

### **Conclusion**

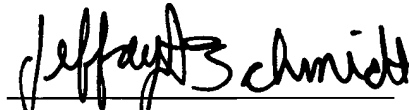
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111  
U.S. Appln No. 09/774,576

Atty. Dkt No. Q62956

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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